

REMARKS

The pending claims have been amended to conform to the restriction requirement. The embodiment of L²-X-L¹ is as elected from claim 38. The definition of X has thus been omitted from claim 1 as redundant, as have the prescribed distances between Ar and the α ring and the proviso regarding L²-X-L¹. As claim 1 has been amended to conform to the restriction requirement, certain claims dependent thereon now fall within the scope of the elected invention. These are claims 2-9, 11-12 and 40-61. Claims to pharmaceutical compositions and methods to use the compounds of the invention have been amended to depend from claim 1 and are thus within the scope of the examined invention. Accordingly, it is believed that the claims, as now proposed, are consistent with applicants' election.

Typographical errors in claims 43 and 44 have been corrected.

Applicants appreciate the recognition that the subject matter of claim 39 is allowable.

The Rejections

Claims 1, 10 and 35-38 were rejected under 35 U.S.C. § 112, second paragraph, as assertedly indefinite. Certain terms were objected to; some no longer appear, but others are believed justified.

First, "non-interfering substituents" is not believed indefinite. What is meant by this term is set forth in detail on page 5 of the specification, lines 7-25. As set forth therein, the essential structural features of the compounds of the invention are shown and defined. The substituents are not relevant so long as they do not preclude the compound from inhibiting p38 α -kinase activity – which inhibition can readily be tested. Regardless of the nature of these substituents, the definition of the core structure and essential features is sufficient to distinguish the compounds of the invention from the art. Therefore, the term "non-interfering substituents" is not indefinite.

With respect to "each of W and X is a spacer of 2-6 Å" – it is not clear to applicants why this would be considered indefinite. A specific size range is provided. As the Office itself has

shown, molecular spacing can be determined and bond lengths and angles are readily found in the CRC Handbook of Chemistry and Physics, for example. Therefore, it is unclear to applicants why this phrase would be indefinite or why one of skill could not prepare embodiments that meet this requirement.

With respect to “Ar linked to L²... is 4.5-24 angstroms” – this phrase no longer appears in the claim, as the nature of X has been specified; thus this limitation is unnecessary.

The objected to term in claim 10 is mooted by the cancellation of this claim. The reference to the disclosure of Brana CA 137 is discussed in connection with the rejection under § 102(f) set forth below.

The further rejection of claim 10, based on the CRC Handbook, is also mooted by the cancellation of this claim.

Claims 1, 10 and 35-38 were rejected as anticipated by Brana, *et al.* Respectfully, either Brana or the claims themselves have been misread. As noted, the invention as now prosecuted (by virtue of applicants’ election) is limited to a spirane where the linking groups are coupled to the nitrogens in the spirane. In the compounds shown by Brana, only the phenyl group is ultimately linked to a nitrogen; the indole is linked to a ring carbon, thus distinguishing the invention compounds. Further, the indole lacks the required substituent CA or CR²A. Thus, there are a multiplicity of differences between the compound disclosed by Brana and the compounds claimed herein.

Applicants further note that the disclosure of Brana post-dates the application date of the present invention. It is unclear what is meant by “since the specification did not disclose [sic] such compounds yet the compounds meet the claims, a 102(f) issue must be raised [sic] as to who is the first to invent the “claimed” compounds.” It is unclear to applicants how a genus which includes these compounds could be not disclosed when the claims to the genus appear in the original application, as does the genus itself appear in the specification *per se*.

In any event, the compounds of Brana clearly are not within the scope of the present claims.

Claims 1, 10 and 35-38 were rejected as asserted anticipated by Kon, *et al.*, CA 118, Hall, *et al.*, CA 123 or Biller, *et al.*, CA 128. None of these compounds contain the embodiment of L²-X-L¹ that corresponds to the elected invention. All of the claims presently pending require the spirane structure shown; the spirane structure does not appear in any of these cited documents. For completeness, it is further noted that the compounds in the cited documents also do not include the required embodiment of Z² as CA or CR²A.

CONCLUSION

It is believed that the present claims conform to applicants election and are free of the art. Therefore, it is respectfully requested that claims 1-9, 11-12, 39-61 and 63-68 be deemed allowable and pass to issue forthwith.

In the unlikely event that the transmittal letter is separated from this document and the Patent Office determines that an extension and/or other relief is required, applicants petition for any required relief including extensions of time and authorize the Assistant Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to **Deposit Account No. 03-1952** referencing docket No. **219002029100**.

Respectfully submitted,

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